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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Lauri Piikivi

617-010487-US(PAR)

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12/14/2005

PERMAN & GREEN
425 POST ROAD
FAIRFIELD, CT 06824

EXAMINER

TESLOVICH, TAMARA

ART UNIT

PAPER NUMBER

2137

DATE MAILED: 12/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/928,026	PIIKIVI, LAURI	
	Examiner	Art Unit	
	Tamara Teslovich	2137	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This action is in response to the Arguments filed on August 29, 2005.

Claims 1-16 are herein considered.

Response to Arguments

Applicant's arguments filed August 29, 2005, with respect to the rejection(s) of claim(s) 1-16 under 35 USC 102(e) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of newly found prior art.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Dominguez et al. (US Patent Application Publication 2002/0194138).

As per Claim 1, Dominguez teaches a device comprising connecting means for establishing a communication link with a second party and selection means connected

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to receive a control message signal from said second party said signal including a plurality of selectable security protocols and in response thereto to select one of the plurality of security protocols whereby information transferred subsequently between the device and second party is protected using the selected security protocol (pars 69-70, 76, 82).

As per Claim 2, Dominguez teaches selection means further comprises analysis means which analyze the data contained in said control message signal and in response thereto selects the security protocol (pars 76, 82).

As per Claim 3, Dominguez teaches calculating means for generating an EMV cryptogram from data held in at least one data field of the control message signal (pars 68-69, 219).

As per Claim 4, Dominguez teaches cryptogram transmitting means provided to transmit the EMV cryptogram from the mobile station to initiate secure transfer of information from the device (pars 68-69, 219).

As per Claim 5, Dominguez teaches means to provide a start payment signal from the device to the second party which thereby initiates the control message signal from the second party (par 33).

As per Claim 6, Dominguez teaches means for communicating, when said selected security protocol is the SET standard, with a modified SET wallet server which is adapted to receive an EMV cryptogram generated by the device and thereafter to communicate with a SET payment gateway via the second party according to the SET standard (par 45). Note: The Examiner has relied on the above-cited paragraph to

demonstrate Dominguez's use of secure wallets within his invention and the modes of communication associated with them. Although Dominguez fails to specifically mention the term "SET" within his disclosure, it should be brought to the Applicant's attention that the technical specification for security financial transactions on the internet, today known as SET, was introduced by VISA in conjunction with MasterCard in 1996, over 4 years before the filing of the prior art at hand.

As per Claim 7, Dominguez teaches means for communicating, when said selected security protocol is the EMV standard, with the second party directly via an EMV cryptogram generated via the device (par 68-69, 219).

As per Claim 8, Dominguez teaches 1 wherein the control message signal comprises a series of data fields each containing data indicating a predetermined parameter for the transaction (pars 72-76).

As per Claim 9, Dominguez teaches wherein the control signal includes a data field which indicates whether the device can communicate directly with the second party or with the second party via a modified SET wallet (par 45).

As per Claim 10, Dominguez teaches internet browsing circuitry which enables a user of the device to access and browse the internet via the device (pars 14, 33, 35, 36, 38).

As per Claim 11, Dominguez teaches connecting means enables a connection to be established between said device and a second party via the Internet (pars 14, 33, 35, 36, 38).

As per Claim 12, Dominguez teaches wherein said device comprises a mobile station (par 38).

As per Claim 13, Dominguez teaches wherein said second party comprises a merchant server associated with a merchant offering an item to be purchased (par 3).

As per Claim 14, Dominguez teaches a device comprising connecting means for establishing a communication link with a second party, selection means for selecting one of a plurality of security protocols and being connected to communicate said selection to said second party (pars 69-70, 76, 82), calculating means for generating an EMV cryptogram for transmittal from said device (par 68-69, 219), whereby information transferred subsequently between the device and second party is protected using the selected security protocol (pars 69-70, 76, 82).

As per Claim 15, Dominguez teaches a device comprising connecting means for establishing a communication link with a second party, selection means for selecting a SET security protocol and being connected to communicate said selection to said second party, and calculating means for generating an EMV cryptogram for transmittal from said devices whereby information transferred subsequently between the device and second party is protected using the SET security protocol (pars 45, 69-70, 76, 82).

Note: The Examiner has relied on the above-cited paragraphs to demonstrate Dominguez's use of secure wallets within his invention and the modes of communication associated with them. Although Dominguez fails to specifically mention the term "SET" within his disclosure, it should be brought to the Applicant's attention that the technical specification for security financial transactions on the internet, today

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known as SET, was introduced by VISA in conjunction with MasterCard in 1996, over 4 years before the filing of the prior art at hand.

As per Claim 16, Dominguez teaches a device comprising connecting means for establishing a communication link with a second part, selection means for selecting a EMV security protocol and being connected to communicate said selection to said second party (pars 69-70, 76, 82), whereby information transferred subsequently between the device and second party is protected using the EMV security protocol (pars 68-69, 219).

Claims 1-2, 5, 8-10, 11, and 13 are rejected under 35 U.S.C. 102(e) as being anticipated by Williams et al. (US Patent No. 5,963,924).

As per Claim 1, Williams teaches a device comprising connecting means for establishing a communication link with a second party and selection means connected to receive a control message signal from said second party said signal including a plurality of selectable security protocols and in response thereto to select one of the plurality of security protocols, whereby information transferred subsequently between the device and second party is protected using the selected security protocol (col.14 lines 8-24; col.14 line 64 thru col.15 line21; col.16 lines 53-56; col.21 line 35 thru col.22 line 8).

As per Claim 2, Williams teaches analysis means which analyze the data contained in said control message signal and in response thereto selects the security protocol (col.13 lines 51-54; col.15 lines 54-56; col.16 lines 53-56).

As per Claim 5, Williams teaches means to provide a start payment signal from the device to the second party which thereby initiates the control message signal from the second party (col.15 lines 53-55).

As per Claim 8, Williams teaches wherein the control message signal comprises a series of data fields each containing data indicating a predetermined parameter for the transaction (col.15 lines 53-55).

As per Claim 9, Williams teaches wherein the control signal includes a data field which indicates whether the device can communicate directly with the second party or with the second party via a modified SET wallet (col.14 lines 8-24).

As per Claim 10, Williams teaches internet browsing circuitry which enables a user of the device to access and browse the internet via the device (abstract, col.10 line 38 thru col.11 line 12; col.9 lines 27-67).

As per Claim 11, Williams teaches wherein said connecting means enables a connection to be established between said device and a second party via the Internet (abstract, col.10 line 38 thru col.11 line 12; col.9 lines 27-67).

As per Claim 13, Williams teaches wherein said second party comprises a merchant server associated with a merchant offering an item to be purchased (abstract, col.10 line 38 thru col.11 line 12).

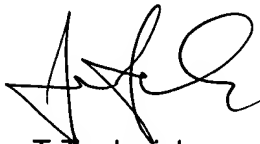
Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The enclosed materials have been included by the Examiner as additional references and examples of electronic payment systems.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamara Teslovich whose telephone number is (571) 272-4241. The examiner can normally be reached on Mon-Fri 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on (571) 272-3865. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



T. Teslovich
December 7, 2005



MATTHEW SMITHERS
PRIMARY EXAMINER
Art Unit 2137